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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,785	11/09/2001	Todd A. Merritt	500345.02	1320

7590 04/08/2003

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EXAMINER

TRAN, DENISE

ART UNIT	PAPER NUMBER
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2186

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,785

Applicant(s)

MERRITT, TODD A.



Examiner

Denise Tran

Art Unit

2186

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2002 and 10 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59, 64 and 65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-53 is/are allowed.
- 6) ☒ Claim(s) 54-59, 64 and 65 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 December 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

FINAL ACTION

1. The applicant's amendment filed 12/27/02 has been considered. Claims 1-59 and 64-65 are pending in the application. Claims 60-63 and 66-78 have been canceled.
2. The Reissue Declaration filed 2/10/03 has been received.
3. The objections to the figures 2-4 is **withdrawn** due to the applicant's amendment filed 12/27/02.
4. Claims 1-53 are **allowable** over the prior art of record.
5. Claims 54-59 and 64-65 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissued is based, as stated in the previous action. The rejections are **maintained**.
6. Applicant's arguments filed 2-10-03 have been fully considered but they are not persuasive.
7. In the remarks, the applicants argued that the output buffer of claim 1 is patentably distinct from the methods of claims 37 and 41 since the methods of claims 37 and 41 can be practiced by an apparatus that is different from the methods of claim

1, and the apparatus of claim 1 can operate in a manner that is different from the methods of claims 37 and 41.

The examiner disagreed with the applicant's arguments because in this case, the output buffer of claim 1 and the methods of claims 37 and 41 direct to the similar subject matter, such as generating data read signals corresponding to complementary data signal when an inactive mask signal is applied; generating data read signals in a predetermined manner when an active signal is applied; generating an output signal corresponding to the data signals if the read data signals are not in the predetermined manner; and placing the data output terminal at a high impedance if the read data signals are in the predetermined manner. The apparatus of claim 1 operates in the manner that is similar to the methods of claims 37 and 41. In particular, the original claims 1, 37, and 41 were rejected under the combination of Applicant's Admitted prior art, Applicant's specification pages 1-4 and drawings 1-4, in view of Kwon (5,414,379) as stated in the office action mailed 3/9/1999.

8. In the remarks, the applicant argued that in amending claim 1 to add the subject matter of claim 4 or the subject matter of other dependent claims, applicant did not surrender the subject matter of method claims 54-59 and 64-65.

The examiner disagreed to the applicant's argument because the subject matter of the original filed claims 37, 41 directs to the similar subject matter of the original filed claim 1 as discussed above. The omission of limitations in the original filed claim 4 or the original filed claims 8 and 9 in the reissue claims 54-59 and 64-65 is a broadening

Art Unit: 2186

in an aspect of the reissued claims 54-59 and 64-65 related to surrendered subject matter.

9. In the remarks, the applicant argued that even if applicant surrendered the subject matter of claims 37 and 41, the applicant did not surrender the narrower subject matter of claims 54-59 and 64-65.

The examiner disagreed to the applicant's argument because the subject matter of the canceled claims 41-42 is the same as the subject matter of the reissued claims 64-65. The subject matter of the canceled claims 37, 41 directs to the similar subject matter of the original filed claim 1 as discussed above. The omission of limitations in the original filed claim 4 or the original filed claims 8 and 9 in the reissue claims 54-59 and 64-65 is a broadening in an aspect of the reissued claims 54-59 and 64-65 related to surrendered subject matter.

10. As explained above, the examiner's position is that the apparatus claims (1-53) and the method claims (54-59 and 64-65) are not directed to independent and distinct inventions. If applicant is of the opinion (as argued in the response dated 12/27/02) that the two groups of claims are restrictable as method and apparatus then applicant should cancel the method claims and prosecute such claims in a divisional application.

Applicant is referred to 37 C.F.R. § 1.176 and MPEP §1450 and §1451 for restriction practice in reissue applications. Note specifically 37 C.F.R. § 1.176(b) under

Art Unit: 2186

which the original patent claims are to be treated as constructively elected unless specifically disclaimed by applicant.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Denise Tran whose telephone number is (703) 305-9823. The examiner can normally be reached on Monday, Wednesday, and an alternate Thursday from 8:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on (703) 305-3821. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 7467-239 for

Art Unit: 2186

Official communications, (703) 746-7240 for Non Official communications, and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

D.T.
April 2, 2003

Kevin L. Ellis
Primary Examiner

